

Remarks

Upon entry of the foregoing amendment, claims 77-97, 122-141, 166-186, and 205-246 are pending in the application, with claims 77, 122 and 166 being the independent claims. Claims 98-121, 142-165 and 187-204 have been cancelled without prejudice to or disclaimer of the subject matter therein. Applicants reserve the right to pursue the subject matter of the cancelled claims in this or another application.

The Restriction Requirement

In reply to the Examiner's request for an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect, *with traverse*, to prosecute the subject matter of Group I, represented by claims 77-97, 122-141 and 166-186.

This election is made without prejudice to or disclaimer of the other claims or subject matter disclosed. Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final. In such case, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it

on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made.

The Examiner asserts that the peptides and peptide compositions of Group I (claims 77-204), the methods of treatment of Group II (claims 205-213, 219-227 and 233-241) which comprise administering the peptides of Group I, and the methods of detecting of Group III (claims 214-218, 228-232 and 242-246) which comprise detecting a response against the peptides of Group I are distinct subject matter. (*See* Paper No. 23, page 2.) Even assuming that these claims represent distinct or independent subject matter, Applicants submit that a search of the peptides of Group I would provide useful information for the methods of Groups II and III. Applicants submit that publications which disclose the claimed peptides normally also disclose therapeutic and/or diagnostic uses for such peptides. Thus, since the searches for the inventions of Groups I, II and III would overlap, the search and examination of all these groups would not entail a serious burden.

Moreover, although not acquiescing to the Examiner's restriction requirement, Applicants note that the claims of Groups I, II and III are related as between a product and a process for using the product, and further, that the processes of claims 205-218, 219-232 and 233-246 depend from and include all the limitations of the products of claims 77, 122 and 166, respectively. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the

treatment of product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Id. Accordingly, Applicants respectfully request that if any of the claims of Group I, *i.e.*, any of pending claims 77-97, 122-141 and 166-186, are found allowable, that the process claims of Groups II and III be rejoined and examined for patentability.

In addition, the Examiner required an election of species if Applicants elected the invention of Group I. To be fully responsive, Applicants hereby provisionally elect: (a) the peptide GVAGALVAFK (SEQ ID NO:3584); and (b) the composition containing a T helper epitope. In view of this provisional election, independent claims 166-168 and 170-186 read on the provisionally elected species, with claim 166 being generic. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

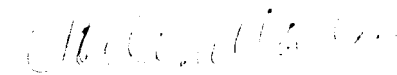
Applicants assert the right to claim additional species in the event that a generic claim thereto is found to be allowable in accordance with 37 C.F.R. § 1.141(a). This election is made without traverse.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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Version with markings to show changes made

In the Claims:

Claims 98-121, 142-165 and 187-204 have been cancelled.

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